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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,978	02/06/2002	Eric E. Swayze	IBIS-0403	1815

34138 7590 08/18/2005

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EXAMINER

HABTE, KAHSAI

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,978

Applicant(s)

SWAYZE ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,63-94,96 and 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-20,63-94,96 and 97 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/28/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Prosecution has been reopened (refer to communication dated 7/7/2005).
2. Claims 1, 3-20, 63-94 and 96-97 are pending in this application.

Claim Objections

3. Claim 79 is objected to because of the following informalities: In claim 79 (page 16, last line), the phrase "-CH₂ enzimidazole" is a typographical error. It should read as "-CH₂ benzimidazole".
4. Claims 11, 18 and 19 are objected to because some bonds and substituents in the chemical structures are not drawn properly. It is recommended that applicants draw these chemical structures as it was done in claims 1, 63 and 73.
5. Claim 63 is objected because "or R'₁₅ and R'₁₆" is a typographical error. It should read as "R'₁₅ and R'₁₆".

It is also recommended that applicants amend the claims according to the Examiner's amendment on 2/25/2004.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 73 and 76-83 are rejected under 35 U.S.C. 102(b) as being anticipated by Janssen et al. WO 01/00615 A1. Cited reference teaches compounds of interest that are the same as applicants for example at pages 67-68 (Table 4, compounds 1, 4-5, 9, 12, 17, 23, 90, 109, 111 and 113), at page 70 (compound 135), at page 72 (compound 59), at page 73 (compounds 74, 76-77 and 79-80), at pages 74-75 (Table 10, compounds 93, 96, 98 and 114) and at page 75 (Table 11, compound 147). Said compounds are the same as applicants when applicant's formula in claim 73 has the following substituents:

R_{2a} = optionally substituted heterocycloalkylamino and R₃₀ = optionally substituted heteroarylalkyl for example with alkyl, OH, halogen, trihaloalkyl, and heterocycloalkyl.

Since said compounds are the same as applicants, a 102(b) rejection is proper.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1, 3-20, 63-94 and 96-97 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claim 1 (page 5), the phrase "R¹⁵ and R¹⁶ together with the nitrogen atom to which they are attached can form a group of Formula I wherein said nitrogen atom is Q4 thereof" is not clear. What is formed? It is unclear what is formed and where this "group of Formula I" is attached to the rest of the molecule. What is the relation between the "group of Formula I" and Q4? Q4 is N and already has three bonds. If it is bonded to another substituent, it will be charged.

b. In claim 63, "a fused ring derivative" is indefinite. What is covered and what is not?

c. In claim 73, the phrase "group of Formula I" lacks antecedent basis. What is "group of Formula I"? Note that claim 73 is an independent claim and recite compound of Formula and not "group of Formula I".

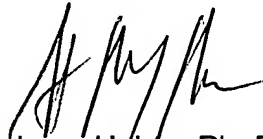
Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte, Ph. D.
Examiner
Art Unit 1624

KH
August 15, 2005